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CHARLES ELIJAH DROPLEY
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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1944.

MINNESOTA MINING & MANUFACTURING
COMPANY,

Petitioner,

vs.

CONWAY P. COE, COMMISSIONER OF
PATENTS

}

No. 738

ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE
DISTRICT OF COLUMBIA

PETITION FOR REHEARING.

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PETITION FOR REHEARING.

To the Honorable Harlan Fiske Stone, Chief Justice of the United States, and the Associate Justices of the Supreme Court of the United States:

The above named petitioner presents this, its petition for rehearing and for reconsideration of the order denying the instant petition, in the belief that there are present in this case compelling reasons which justify the grant of the writ.

The reasons which petitioner failed to make clear are these:

The decision of the Court below, written by Associate Justice Thurman Arnold, by which the action of the Patent Office in refusing certain patent claims to petitioner was affirmed, vitally affects the absolute property rights of all inventors in that it holds that they may not henceforth solicit patents and conduct their economic affairs within the scope of the present patent statutes, but rather re-

quires that they submit to and comply with certain wholly novel standards and tests adopted by the Court as prerequisites to the grant of patents. These tests and standards, bottomed on considerations of the monopoly and industrial control problems of our economy, rather than on the provisions of the statutes, are set forth elaborately in Judge Arnold's opinion in *Monsanto Chemical Co. v. Coe* (App. D. C.), 145 F. (2d) 18, cited by him as the controlling authority for the ruling made in the case at bar (Rec. 419; 145 F. (2d) 25).

The instant attempt by Judge Arnold to write doctrinaire reforms into the patent statutes on the ground that their present provisions are unwise and are being administered, both by the Patent Office and the courts, prejudicially to the interests of the public, presents, in our submission, an urgent need for this Court to exercise its supervisory power of review. Substantially all of the actions brought under § 4915 R. S. (35 U. S. C. § 63)¹ by applicants to whom patents have been refused in *ex parte* cases by the Patent Office are commenced in the United States District Court for the District of Columbia and the decisions of the Court below are controlling in the adjudication and disposition of those actions. Moreover, that Court's decisions are intended for the guidance of the Patent Office in its administration of the patent statutes. Hence, if erroneous, the rule adopted in the instant case, will produce unfortunate consequences in practice.

As a further ground of rehearing, we observe that the recent decision of this Court in *Hartford-Empire Co. v. United States*, U. S., 89 L. Ed. Ad. Op. 302, decided on January 8, 1945, subsequent to the filing of the petition for certiorari herein, has clearly revealed the untenable basis of the decision of the Court below. In that

¹ Appendix, post p. 14.

case, this Court, contrary to a mistaken view of trend taken by the Court below, reaffirmed the long settled doctrine that "a patent is property, protected against appropriation both by individuals and government." Whereas, as we presently show, the Court below held that vital public interests demand that patent rights be granted only when the Courts are fully apprised of the industrial control which a patent probably will give, Mr. Justice Roberts, writing the opinion for this Court in the *Hartford* case, said that a patent owner is "not in the position of a quasi-trustee for the public or under any obligation to see that the public acquires the free right to use the invention" or under any obligation "either to use it or grant its use to others." And where the Court below has ruled that patent claims will not be awarded in the absence of "information as to the effect² on the building trades of giving the plaintiff separate patent rights on the use of particular ingredients" this Court has held in the *Hartford* case that if an inventor "discloses the invention in his application so that it will come into the public domain at the end of the 17 year period of exclusive right he has fulfilled the only obligation imposed by the statute."

The Court below adopted its industrial control standard because (a) it considers the long standing judicially sanctioned practice which permits multiple claims in a patent to be responsible for a confusion of the issues of invention and scope;³ (b) it regards patents for chemical pro-

² From *Monsanto Chemical Co. v. Coe*, it will appear that this is a requirement that the patent applicant supply evidence by disinterested witnesses, *preferably his competitors*, as to the degree of control which he reasonably expects, and which the competitors reasonably fear, from the grant of the claims requested.

³ The rule is that each claim embodies a complete invention and is in effect an independent patent for the device it covers. See *Leeds & Catlin v. Victor Talking Mach. Co.*, 213 U. S. 301, 319, and *Veneer Mach. Co. v. Grand Rapids Chair Co.*, (C. C. A. 6) 227 Fed. 419, 425.

cesses and those based on scientific principles to be inimical to our economy since they are concerned with ways of doing things rather than with the machines which do them,⁴ and (e) it regards our complex modern technology to be of such character that patents should no longer be granted without expert evidence from men who know the industrial field. In short, a standard of "patent scope" measured only in the light of probable industrial control has been adjudged by the Court below to be a substitute for the present statutory requirements of invention, novelty and utility (145 F. (2d) 18).

Thus, it appears in the instant case that the Court below, without actually considering the claims which had been refused to petitioner by the Patent Office, treated all of them as mere "permutations and combinations" in the general formula covered in allowed claims and held that petitioner was not entitled to a patent for all of the claims because there was here "no information as to the effect on the building trades" of giving the petitioner "separate patent rights," citing, as the basis of this ruling, the decision in *Monsanto Chemical Co. v. Coe*. Realizing that two claims sought by petitioner had been copied from an issued

⁴ Ever since *Cochrane v. Deener*, 94 U. S. 780 and *Tilghman v. Proctor*, 102 U. S. 707, processes have been held to be as much entitled to the protection of the law as a machine or manufacture. The essence or gist of a process is its principle and mode of treatment, this being an act or series of acts performed either chemically or physically upon the subject matter to be transformed and reduced to a different state or thing. This Court has unequivocally ruled that a process is patentable "irrespective of the * * * instrumentalities used" (94 U. S. 787) and that "The inventor is not bound to describe them all in order to secure to himself the exclusive right to the process if he is really its inventor or discoverer" (102 U. S. 728).

Any construction of the patent laws which protects the inventor in no more than the tools or appliances used in his process is a clear annulment of the law. It ignores the distinction between a process and a machine and in effect refuses the full protection of the patent laws to the inventor of a new and useful process.

patent to one Veazey and therefore are already at large in the affected industry, the Court attempted to bridge the inconsistency apparent on the face of its opinion by purporting to consider these claims specifically. In seeming discharge of its judicial function, the Court held that these claims could not be had by petitioner because it "appears" that the Patent Office *might* have made a mistake in granting them to Veazey. If this was so, said the Court, the situation is not improved "by a second mistake of allowing the same claim" to petitioner. Neither the trial Court nor the Court below has expressly found that the Patent Office did actually make a mistake in originally granting the Veazey claims. If in fact the Veazey claims are valid and patentable, as construed by petitioner, then petitioner has been deprived of an absolute property right and has been denied its substantive rights, under §§ 4904 and 4918 (35 U. S. C. §§ 52, 66)⁵, to contest the issue of priority with Veazey.

The only question presented on appeal in the Court below as to the Veazey claims was the legal question of whether or not there is support for them in petitioner's application. This is the same legal question presented to this Court by Question 4 of the petition for certiorari. Petitioner hereby waives consideration by the Court of all of the requested claims, save its claims 71, 72, 92 and 93 (Rec. pp. 25, 27) which are respectively claims 8 and 9 of the Veazey Patent and two article claims based thereon.⁶

⁵ Appendix, post pp. 14, 15.

⁶ The Veazey patent claims are *prima facie* valid and patentable and the burden of challenging them is a heavy one. *Radio Corp. v. Radio Eng. Laboratories*, 293 U. S. 1; *Mumm v. Decker*, 301 U. S. 168. Furthermore, the authority which granted them is estopped to attack their validity. *United States v. American Bell Telephone Co.*, 167 U. S. 224; *United States v. United States Gypsum Co.*, 53 F. Supp. 889. If the instant petition for certiorari is granted, the only question which this Court need decide is the legal one of whether or not petitioner's application will support these claims.

**THE MONSANTO RULE WHICH WAS INVOKED AGAINST
PETITIONER IS ENTIRELY WITHOUT STATUTORY WAR-
RANT AND IS IN CONFLICT WITH APPLICABLE DE-
CISIONS OF THIS COURT.**

The rule of the *Monsanto* case which was applied by the Court below is a wholly novel one and constitutes a major departure from a patent policy and practice of long standing. There is no warrant or authority for the rule under any fair and reasonable construction of the present patent statutes. Indeed, although Judge Arnold disclaimed any assertion of a "new principle," his decision is clearly a *judicial* rather than *legislative* reformation of the patent statutes, based on considerations of economies and monopoly problems, whereby questions of the "scope" of patents are required to be "treated in the light of industrial facts." According to this unprecedented doctrinaire dogma, questions of patentability such as whether a patent should be granted "on mere novelty" or restricted to a "veritable flash of genius" become *academic* and the "real problem" is that of preventing "patents from becoming a monopoly on technical progress in defiance of the Constitution." Under the *Monsanto* rule, the *sole* question to be determined by the Patent Office and the Courts, as a prerequisite to the grant of a patent, is the "amount of control that should be allowed to the inventor as his reward."⁷

In formulating the *Monsanto* rule, the Court below held that vital public interest demands that the broad discre-

⁷ Patentability is presently required by this Court (*Cuno Corp. v. Automatic Devices Corp.*, 314 U. S. 84, 91) to depend not only on novelty but also on invention revealed in the form of a "flash of creative genius, not merely the skill of the calling." The *Monsanto* rule as to scope, however, disregards this requirement and would permit gadget patents "of little scope" to issue on the ground that they are "safe enough." Even "bright idea patents short of genius" may be safely awarded, provided that they are limited in scope as required by their probable impact upon industry.

tionary judgment vested in the Patent Office by the present patent statutes be exercised *only* when evidence is presented "on the industrial control which the patent probably will give." Thus it was held that the Courts, and of course, the Patent Office, which first acquires jurisdiction over an application, must examine the actual degree of control which the inventor hopes to gain by means of all his claims taken as a whole "over competing industry and competing invention." By a palpably arbitrary fiat, it was also ruled that the best evidence with which to meet the inquiry satisfactorily is that of "disinterested experts or competitors who are aware of the monopoly problems in the field of the patent." Although, under the present system, the Patent Office represents the public and its interests, the rule adopted by the Court below requires, in effect, that an applicant must supply evidence from his competitors that they will not be affected by the scope of the solicited claims. The mere statement of the rule reveals its absurdity, and yet, the Court below held that without such evidence a patent application record was similar to a "case in which the testimony of an interested adverse party has been excluded."

As every one well knows, the patent application of an inventor is a carefully guarded secret until the patent issues. This is a protection made available by the present patent statutes, but under the *Monsanto* rule this statutory privilege of secrecy is to be violated, and an applicant is to be required to disclose his pending application to his competitors in order to secure their *required* testimony as to the probable industrial control which will result from the issuance of the patent.

If a claim is to be regarded as too broad solely on considerations of the probable industrial control which might be exercised, then the rights of inventors are being made subject to modifications and qualifications dictated by the economic interests of competitors; they are being made to

conform to an economic and social program not provided for by the patent statutes and the inventor is being required to conduct his affairs and compete with others on a level insisted upon by these others.

This procedure violates the letter and spirit of our present patent laws. *The exclusion of competitors* from the use of a new improvement is the *very essence* of the right conferred by patent. If an inventor, following the patent statutes, proceeds to disclose his invention to the public, he is entitled to "insist upon all the advantages and benefits which the statute promises to him" (*Paper Bag Patent Case*, 210 U. S. 409, 424).⁷

The patent law may be searched in vain for any provision that a patent claim may be withheld when the applicant is claiming no more than that which he invented or discovered.

The only prerequisite, prescribed by the patent statutes, to the grant of an exclusive patent privilege is that the improvement shall possess invention, novelty and utility, that is to say that it shall not have been "known or used by others in this country * * * not patented or described in any printed publication * * * and not in public use"

⁷ The Constitution declares that "Congress shall have the power to promote the progress of science and useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries." Art. I, § 8, cl. 8. The *exclusive* patent right which Congress has authorized under this constitutional power is *property*. The essence of this constitutional property right is the privilege of the patent owner to use, or not to use, his invention, without question of motive (*Paper Bag Patent Case*, 210 U. S. 409, 429) and the right to *exclude* every one from its unpermitted use for the time prescribed in the statute (*Bloomer v. McQuewan*, 14 How. 539, 549). The public faith is forever pledged for this exclusive enjoyment (*Grant v. Raymond*, 6 Pet. 218, 243) as the consideration for the invention coming into the public domain upon expiration of the patent.

(35 U. S. C. § 31).⁹ The scope of the exclusive privilege is that determined by the extent of the invention, as accurately measured by the state of the prior art and knowledge (*Garneau v. Dozier*, 102 U. S. 230, 234; *Eibel Co. v. Minnesota etc. Co.*, 261 U. S. 45, 63).

The present laws (35 U. S. C. 33)¹⁰ require an inventor, as a condition precedent to obtaining a patent, to deliver to the Commissioner of Patents a written description of his invention or discovery and "of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound and use the same." This is the obligation imposed for the benefit of the public so that the invention as patented may come into the public domain at the end of the period of exclusive right.

The statute (35 U. S. C. § 33) also requires that the applicant for patent "shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery." The claims of a patent have consequently been held to be creatures of statute, in which the inventor is required to define precisely what his invention is (*White v. Dunbar*, 119 U. S. 47, 51). The prevailing rules by which the scope of claims is governed are those announced by this Court in the *Motion Pictures Patent Case*, 243 U. S. 502, and *United Carbon Co. v. Binney & Smith Co.*, 317 U. S. 228. Thus, a claim is the measure of the patented invention, e.g., its metes and bounds, and need only "clearly distinguish what is claimed from what went before in the art."

The present patent statutes (35 U. S. C. § 36)¹¹ require

⁹ Appendix, post p. 13.

¹⁰ Appendix, post p. 13.

¹¹ Appendix, post p. 14.

the Commissioner of Patents, on the filing of an application for patent, to "cause an examination to be made of the alleged new invention or discovery." If on such examination it shall appear to the Commissioner "that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent."

There is thus nothing in the present statutes, either in the form of obligations imposed upon applicants or in the form of authority vested in the Commissioner of Patents, which requires the former to supply, or the latter to require, evidence in the light of the industrial facts as to the probable control which the inventor may reasonably expect, or his competitors may reasonably fear, from the grant of the requested claims.

If the Commissioner of Patents believes that the claims are not patentable and rejects them, then the applicant may have the patentability of the claims reconsidered by the Courts by means of an action under § 4915, R. S. (35 U. S. C. § 63). Neither the District Court nor the Court of Appeals in such an action should be permitted to avoid, under the present patent statutes, a consideration of the patentable novelty of the requested claims on the grounds set forth in the *Monsanto* case, that an applicant must first supply evidence of the effect or impact upon industry which the scope of the claims requested by him will probably have. Therefore, since this novel test does not find expression in the statutes, this Court should not give it continuing vitality as a standard by which the issuance of patents is to be determined. The *Monsanto* rule invoked by the Court below against petitioner is also in direct conflict with the governing rule of law recently reaffirmed by this Court in the *Hartford* case when it quoted the follow-

ing from *Chapman v. Wintroath*, 252 U. S. 126, 137 and *United States v. American Bell Telephone Co.*, 167 U. S. 224, 247:

"A party seeking a right under the patent statutes may avail himself of all their provisions, and the courts may not deny him the benefit of a single one. These are questions not of natural but of purely statutory right. Congress, instead of fixing seventeen, had the power to fix thirty years as the life of a patent. **No court can disregard any statutory provisions in respect to these matters on the ground that in its judgment they are unwise or prejudicial to the interests of the public.**"¹²

There can be no question of the *exclusive* power of Congress to define the nature of the patent privilege now available under the existing patent statutes. Congress, exercising its plenary control over patents, has not thus far seen fit to adopt the social reforms promulgated by the Court below. With the wisdom of that action the Court below should have had no concern.

As was said by Mr. Justice Black in *United States Ex Rel. Marcus et al. v. Hess et al.*, 317 U. S. 537:

"The government presses upon us strong arguments of policy against the statutory plan, but the entire force of these considerations is directed solely at what the government thinks Congress should have done rather than at what it did. It is said that effective law enforcement requires that control of litigation be left to the Attorney General; * * * and finally that conditions have changed since the Act was passed in 1863. **But the trouble with these arguments is that they are addressed to the wrong forum. Conditions may have changed, but the statute has not.**"

¹² Emphasis in quotations has been added.

For the reasons stated, it is respectfully urged that this petition for a rehearing be granted and that, upon further consideration, the order of this Court denying the petition for a writ of certiorari be vacated and the said petition be granted.

Respectfully submitted,

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Certificate of Counsel.

The undersigned counsel for petitioner hereby certifies that the foregoing petition for rehearing is presented in good faith and not for delay.

J. BERNHARD THIESS.

